

Appl. No. 09/720,623
AMENDMENT
Docket No. MAEJ-136

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REMARKS

Claims 3, 6, 8-9, and 12-21 are pending. By this Amendment, Claims 1-2, 4-5, 7, and 10-11 are canceled, without prejudice or disclaimer; Claims 3, 6, and 8-9 are amended; and new Claims 12-21 are added. Support for the claim amendments and new claims is found in the specification at, *inter alia*, page 6, lines 11-13, page 7, lines 12-18, page 8, line 24, page 10, lines 11-17 and 21-29, page 11, lines 3 - page 12, line 5; page 17, lines 20-25; in the Examples; and in the original claims. No new matter is added by this Amendment.

I. INFORMATION DISCLOSURE STATEMENT

Applicants respectfully request Examiner Zimmer to initial and return Form PTO-1449 included with the Information Disclosure Statement filed on December 27, 2000. For the Examiner's convenience, a copy of the IDS filed on December 27, 2000 is attached to this Amendment.

II. FORMAL MATTERS

Claim 11 was rejected under 35 U.S.C. 112, first paragraph, as assertedly failing to comply with the written description requirement. Claim 11 is canceled, without prejudice or disclaimer, thereby rendering the rejection moot. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1 and 3-6 were rejected under 35 U.S.C. 112, second paragraph, as assertedly being indefinite. This rejection is variously obviated and traversed.

Claims 1 and 4-5 are canceled, thereby rendering the rejection moot as to those claims. Claims 3 and 6 depend from new Claim 12. New Claim 12 positively recites a reaction step as suggested by Examiner Zimmer. In particular, Claim 12 recites reacting a

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phenolic compound and dicyclopentadiene in the presence of an acid catalyst, wherein the dicyclopentadiene is added to the phenolic compound intermittently or continuously so that the molar fraction of the amount of ether product relative to that of the mixture of products may be 0.1 or more. Further, new Claim 12 recites increasing the temperature to 110°C or higher so as to continue the reaction further and substantially extinguish the ether product. Accordingly, the scope of Claims 3, 6, and 12 would have been reasonably ascertainable to one of ordinary skill in the art when read in light of the specification. The requirements of 35 U.S.C. 112, second paragraph, are satisfied. Reconsideration and withdrawal of the rejection are respectfully requested.

III. REJECTION UNDER 35 U.S.C. 102(b)

Claims 1-5 and 7-9 under 35 U.S.C. 102(b) as anticipated by Bogan (U.S. Patent No. 4,927,905). This rejection is variously obviated and traversed. Claims 1, 4-5, and 7 are canceled, without prejudice or disclaimer, thereby rendering the rejection moot as to those claims. Claims 3 and 8-9 are amended to depend from new Claim 12.

Bogan discloses that hydrocarbon aromatic hydroxyl-containing resins are prepared by (1) reacting an unsaturated hydrocarbon with an aromatic hydroxyl-containing compound in the presence of a Lewis acid, (2) neutralizing the Lewis acid with an inorganic base, and (3) removing the unreacted aromatic hydroxyl-containing compound (Abstract).

Bogan does not disclose reacting a phenolic compound and dicyclopentadiene in the presence of an acid catalyst, wherein the concentration of moisture is maintained at 200 ppm or less, and wherein the dicyclopentadiene is added to the phenolic compound intermittently or continuously so that the molar fraction of the amount of ether product relative to that of the mixture of products may be 0.1 or more, as recited in Claim 12 and

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its dependent claims. As noted in the specification, the moisture content is maintained at 200 ppm or less because phenolic compounds are liable to absorb moisture, thereby affecting the reaction unfavorably. Also, as disclosed in the present specification, conducting the reaction so that the molar fraction of ether product is at least 0.1 provides improved color tone. The Examiner maintains that Bogan discloses the same starting materials and temperatures which fall within the claimed ranges. However, that does not inherently result or teach conducting the reaction to produce the claimed molar fraction. As demonstrated in Example 1 and Comparative Example 1 of the present specification, use of the same reactant ratios and the same reaction temperatures resulted in substantially different ether contents when different catalyst amounts were employed.

Further, Bogan does not disclose that the ratio of ortho/para is 2.0 or more with regard to the substitution position of the unsaturated cyclic hydrocarbon relative to a hydroxyl group of the phenolic compound in the hydrocarbon-phenol resin, as recited in Claim 3.

Bogan does not disclose each and every element of the claimed processes. Accordingly, Claims 3, 8-9, and 12 are not anticipated. Reconsideration and withdrawal of the rejection are respectfully requested.

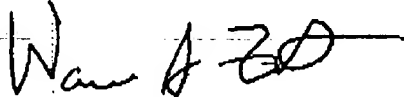
IV. CONCLUSION

In light of the foregoing remarks, this application is in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application.

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If any additional fees are required or if there are any discrepancies in the fees please charge or credit our Deposit Account No. 501032 (Docket No. MAEJ-136).

Respectfully submitted,



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Attachment:

Information Disclosure Statement filed December 27, 2000